

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Interference No. 104,761

UNIVERSITY OF NEW MEXICO
(5,747,332, 6,066,716, and 6,433,141),

Junior Party,

v.

FORDHAM UNIVERSITY
(09/090,754),

Senior Party.

NOTICE REDECLARING INTERFERENCE

A. Redeclaration of interference

The interference is redeclared (35 U.S.C. 135(a)) between the captioned parties. Details of the application, patents, counts, and claims designated as corresponding to the counts appear under headings E and F of this NOTICE.

B. Administrative patent judge assigned to administer the interference

The interference has been assigned to Administrative Patent Judge Richard Torczon. 37 CFR § 1.610.

C. Standing order

The Trial Section STANDING ORDER (Paper 2) continues to apply to this interference.

D. Discussion

The following enumerated findings are supported by at least a preponderance of the evidence.

[1] Fordham moves (Paper 97) to add UNM's 6,433,141 patent to this interference or, in the alternative, to add claims to its own involved application and then have a second interference declared.

[2] UNM opposes this motion (Paper 101).

[3] Fordham has replied (Paper 106).

[4] According to Fordham, its claims 68, 69, 71-75, and 82-88, which correspond to count 3, claim the same patentable invention as claims 1-14 of UNM's 141 patent.

The independent claims of the 141 patent, claims 1, 7, and 10 are [1040 at 5-6]:

1. A purified ADP-heat shock protein-peptide complex wherein said heat shock protein comprises hsp90.

7. A purified ADP-heat shock protein-peptide complex wherein said heat shock protein comprises gp96.

13. A purified ADP-heat shock protein-peptide complex wherein said heat shock protein comprises grp94.

[5] All of the heat shock proteins in UNM 141 claims 1, 7, and 3 are hsp90 family members [1040 at 4:1-2].

[6] Count 3 is "The ADP-heat shock protein-peptide complex of UNM 716 claims 13, 19, or 25."

[7] UNM 716 claims 13, 19, and 25 are:

13. A purified ADP-heat shock protein-peptide complex wherein said heat shock protein is selected from the group consisting of DnaK proteins from prokaryotes.

19. A purified ADP-heat shock protein-peptide complex wherein said heat shock protein is selected from the group consisting of Ssa, Ssb, and Ssc from yeast.

25. A purified ADP-heat shock protein-peptide complex wherein said heat shock protein is selected from the group consisting of Grp75 and Grp78(Bip) from eukaryotes.

- [8] All of the heat shock proteins in UNM 716 claims 13, 19, and 25 are members of the hsp70 family [1008 at 3:62-64].

Fordham presents the same problem in its motion to add the 141 patent claims that it presented in its preliminary motion 4: Given ADP-[hsp70 family member]-peptide complexes, what would be the motivation to substitute an hsp90 family member for the hsp70 family member?

- [9] The Blachere article¹ [1018] provides a motivation to use hsp70, hsp90, or gp96 to chaperone and present antigenic tumor proteins.
- [10] This teaching would have provided the motivation, given knowledge of ADP-[hsp70 family member]-peptide complexes, to make ADP-gp96-peptide complexes or ADP-hsp90-peptide complexes.
- [11] A person having ordinary skill in the art would have known that gp96 and grp94 are essentially the same protein (Paper 97 at 4, Facts 5 & 6, admitted at Paper 101 at 1).
- [12] Fordham has presented numerous facts about actions taken by the examiner and UNM in the prosecution history of the 141 patent and related UNM applications, some of which support the conclusion that ADP-[hsp70 family member]-peptide complexes and

¹ N.E. Blachere et al., "Heat Shock Protein Vaccines Against Cancer", 14 J. Immunol. 352 (1993). Fordham's named inventor, Pramod K. Srivastava, is a co-author.

ADP-[hsp90 family member]-peptide complexes are the same invention and others which do not.

The prosecution history is so equivocal that very little weight can be accorded to it. Cf. Omega Engineering, Inc. v. Raytek Corp., 334 F.3d 1314, 1331, 67 USPQ2d 1321, 1333 (Fed. Cir. 2003) (cautioning against reading much into ambiguous prosecution history).

- [13] UNM's dependent 141 claims parallel each other and parallel Fordham's substantially copied claims for ADP-hsp70-peptide complexes as follows:

UNM 141 independent claim			Added limitations	Fordham claim	Added limitations
1	7	13		68	
2	8	14	combination not naturally occurring	71	made in vitro
3	9	15	hsp & peptide from same individual	72	hsp & peptide from same individual
4	10	16	hsp & peptide from different individuals	73	hsp & peptide from different individuals
5	11	17	hsp & peptide from different organisms	74	hsp & peptide from different organisms
6	12	18	hsp & peptide from different species	75	hsp & peptide from different species

- [14] UNM notes the added limitations in the dependent claims but provides no reason why these claims are patentably distinct from Fordham's claims corresponding to count 3 other than its arguments for the independent claims.

Since Fordham has established that UNM 141 claims 1-8 define the same patentable invention as claims already corresponding to count 3, Fordham's request for an exercise of discretion to add UNM's 141 patent to the interference with claims 1-18 corresponding to count 3 is GRANTED. Consequently, Fordham's suggestion that another interference be declared is DISMISSED as moot.

Fordham requested a hearing if its motion to add was likely to be denied (Paper 105). UNM did not request a hearing on the motion. Since the motion is GRANTED to the extent that all claims of the UNM 141 patent have been added to correspond to Count 3, Fordham's request for a hearing is DENIED as moot.

E. The parties to this interference

Junior Party

Inventors: Erik S. Wallen, Jan Roigas, and Pope L. Moseley

Patent: 5,747,332, issued 5 May 1998 [332]
(08/717,239, filed 20 September 1996)

Title: Methods for purifying and synthesizing heat shock protein complexes

Accorded None
benefit:

Patent: 6,066,716, issued 23 May 2000 [716]
(08/934,139, filed 19 September 1997)

Title: Purified heat shock protein complexes

Accorded 08/717,239 (above)
benefit:

Patent: 6,433,141, issued 13 August 2002 [141]
(09/534,381, filed 24 May 2000)

Title: Purified heat shock protein complexes

Accorded 08/717,239 (above)
benefit: 08/934,139 (above)

Assignee: University of New Mexico [UNM]

Attorneys: See last page

Address: See last page

Senior Party

Inventors: Pramod K. Srivastava

Application: 09/090,754, filed 4 June 1998

Title: Compositions and methods for the prevention and treatment of primary and metastatic neoplastic diseases and infectious diseases with heat shock/stress proteins

Priority 08/527,391, filed 13 September 1995
benefit: (5,837,251, issued 17 November 1998)

Assignee: Fordham University [Fordham]

Attorneys: See last page

Address: See last page

F. Counts and claims of the parties

Count 1

The method of UNM 332 claim 10 OR Fordham claim 62.

Count 3

The ADP-heat shock protein-peptide complex of UNM 716 claims 13, 19, OR 25.

Count 4²

The method of UNM 332 claim 22 OR Fordham claim 96.

The claims of the parties are:

Univ. of New Mexico 332: 1-23
716: 1-30
141: 1-18

Fordham Univ.: 60-69 and 71-96

² Substituted for Count 2 in Paper 98.

The claims corresponding to Count 1:

Univ. of New Mexico 332: 1, 3-5, and 7-12
Fordham Univ.: 60, 62-64, 78, 89, 90, and 92

The claims corresponding to Count 3:

Univ. of New Mexico 332: 13-30
141: 1-18
Fordham Univ.: 68, 69, 71-75, 82-88 and 96

The claims corresponding to Count 4:

Univ. of New Mexico 716: 13, 15-17, and 19-23
Fordham Univ.: 65-67, 79, 80, and 93-95

The claims not corresponding to any count:

Univ. of New Mexico 332: 2, 6, 14, and 18
716: 1-12
141: None
Fordham Univ.: 61, 76, 77, 79-81, and 91

G. Heading to be used on papers

Addendum 1 provides the heading that shall be used on all papers filed in the interference. See STANDING ORDER ¶ 3.5.

RICHARD TORCZON
Administrative Patent Judge

cc (electronic mail):

Paul Adams and Deborah Peacock of PEACOCK, MYERS & ADAMS P.C. for the University of New Mexico, and

Samuel B. Abrams and Michael J. Ryan of PENNIE & EDMONDS LLP for Fordham University (Antigenics, Inc., licensee).

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ADDENDUM 1

Filed on behalf of: Party _____
By: Name of lead counsel
Name of backup counsel
Electronic mail addresses

Paper No. _____³

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TITLE OF PAPER

³ Leave blank for the Board to insert the paper number when the paper is entered into the administrative record.